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Sen'ichi Onoda

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EXAMINER

KIM, STEVEN S

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,024	Applicant(s) ONODA ET AL.	
	Examiner STEVEN KIM	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/22/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the US Application No. 10/540,024, filed on June 22, 2005.

Status of Claims

2. Claims 1-30 have been examined.
3. Claims 1-30 are pending.

Foreign Priority

4. Acknowledgement is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in the instant application, filed on June 22, 2005.

Examiner's Comment

5. The Applicant's claims are replete with functional data, intended use language and non-functional descriptive material. For example, claims 1-3, 8, 9, 11, 17-19 and 22-24 recite right management server and/or user terminal and units, related to the server and the terminal, "operable" to perform intended use functions relating to licensing. Claims 4-6, 10, 12-13, 20 and 22 recite non-functional data such as limitations directed to the content used by the Applicant's content usage/right management system or license data.
6. The claims 1-3, 8, 9, 11, 17-19 and 22-24 are directed to a content management system specific to structure, however the claims also contain intended use language,

Art Unit: 3685

"operable", and thus are not distinguished from prior art if the prior art has the capability to perform, MPEP 2114 and Ex parte Masham, 2USPQ2d 1647 (1967).

7. Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 29 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. In regards to claims 29 and 30, the claims are directed to a computer instruction on a computer-readable medium. The claims are read with broadest interpretation to be a stored program listing on a flash drive or a portable memory. Program or software is a nonfunctional descriptive material that does not constitute a statutory, see, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory), MPEP 2106.01

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. As per claims 1, 17, 22 and 27-30, the Applicant recites a **second condition** that indicates a part or all of the use permitted under the first condition and **indicates whether the license information is valid based on a logical product of the first condition and said second condition**. The claim language uses a circular reference/reasoning in defining a second reference.

14. Claims 2-16, 18-21 and 23-26 are rejected similarly as each depends on claim 1, 17, or 22.

15. As per claims 8 and 23, the claims recite the limitation "the use right" and "the provision". There is insufficient antecedent basis for this limitation in the claim.

16. As per claims 9 and 24, the claims recite the limitation "the number of actual uses" and "the item of the usage amount". There is insufficient antecedent basis for this limitation in the claim.

17. As per claim 13, the term "uniformly" is a relative term which renders the claim indefinite. The term "uniformly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Art Unit: 3685

18. As per claim 15, the claim recites the limitation "the maximum allowable number of use". There is insufficient antecedent basis for this limitation in the claim.

19. As per claims 16 and 24, the claim is rejected since it is unclear what the Applicant is claiming. Specifically, the claim recites "a value of an item of a usage amount included in said license information is not less than a value of the second condition, said usage amount being an item into which the number of actual uses of the content is recorded with a default value being 0 when the content is used based on the license information." Based on the claim language, an ordinary skill in the art would not be able to ascertain clear relationship among value(s), item(s), usage amount and content use nor would the person of ordinary skill in the art ascertain which component(s) is performing the recording. (In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), "... an essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous").

20. Furthermore claim 16 recites the limitation "the number of actual uses". There is insufficient antecedent basis for this limitation in the claim.

21. As per claims 9, 16 and 24, it is unclear what "item of a usage amount" is. Item of usage amount is not disclosed in the specification.

Claim Rejections - 35 USC § 102

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

23. Claims 1-8, 10-13, 17-23, 25 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,892,900 to Ginter et al., hereinafter referred to as “Ginter”.

24. As per claims 1, 2, 17, 18, 22, 23 and 27-30, Ginter discloses a digital content distribution system comprising a right management server and a user terminal which are connected to each other via a communication network, said right management server issuing, to the user terminal, license information for permitting a user to use a content, and said user terminal using the content based on the license information obtained from the right management server (see Fig. 2 and Fig. 2A; col. 3, lines 19-29; col. 9, lines 37-42; col. 7, lines 46-48; col. 1, lines 24-36; col. 2, lines 19-32; col. 5, lines 40-45),

- wherein the right management server includes:
 - a first condition generation unit operable to generate a first condition based on a content use right owned by the user, said first condition

Art Unit: 3685

being a condition for permitting the user to use the content (see Fig 2 and Fig. 2A; col. 3, lines 49-52; col. 6, lines 30-36; col. 8, lines 24-26; col. 9, lines 21-24; col. 13, lines 63-65; col. 16, lines 56-57; Fig. 5A and Fig. 5B, permission records and budgets; col. 134, lines 29-38)

- a second condition generation unit operable to generate a second condition that indicates a part or all of the use permitted under the first condition and indicates whether the license information is valid or invalid based on a logical product of the first condition and said second condition (see Fig 2 and Fig. 2A ; col. 3, lines 49-52; col. 6, lines 30-36; col. 8, lines 24-26; col. 13, lines 63-65; col. 16, lines 56-57; Fig. 5A and Fig. 5B, permission records and budgets; col. 134, lines 29-38; col. 150, lines 43-49)
- a license generation unit operable to generate the license information including the first condition and the second condition in response to a license obtainment request from the user terminal (see Fig 2 and Fig. 2A; col. 13, lines 63-65; Fig. 5A and Fig. 5B, permission records and budgets)
- a license issuance unit operable to issue the generated license information to the user terminal so that said user terminal obtains said license information (see Fig 2 and Fig. 2A; col. 13, lines 63-65; Fig. 5A and Fig. 5B, permission records and budgets),

Art Unit: 3685

- a return acceptance unit operable to accept, from the user terminal, return of the license information which is judged to be invalid (see Fig 2, Fig. 2A and Fig. 41d);
- an invalidation cancellation unit operable to cancel invalidation of the license information by updating the second condition included in the returned license information to a new value (see Fig. 2, Fig. 2A and Fig. 41d; col. 138, lines 14-63); and
- a reissuance unit operable to reissue, to the user terminal, the license information of which invalidation is cancelled (see Fig 2 and Fig. 2A; col. 138, lines 14-63); and
- the user terminal includes:
 - a license obtainment requesting unit operable to request the right management server to issue the license information so as to obtain said license information (see Fig 2 and Fig. 2A;
 - an invalidity judgment unit operable to judge whether the license information is invalid or not based on the first condition and the second condition included in the obtained license information (see Fig. 2 and Fig. 2A;
 - a using unit operable to provide the use of the content to the user when it is judged that the license information is not invalid (see Fig. 2 and Fig. 2A; and

Art Unit: 3685

- a license information returning unit operable to return the license information to the right management server when it is judged that the license information is invalid (see Fig. 2, Fig. 2A and Fig. 41d; col. 138, lines 14-19)

25. As per claim 3, Ginter also discloses wherein the user terminal further includes a history information storage unit operable to generate history information indicating a history of the use of the content when said content is used by the using unit, and store the generated history information, and the license information returning unit transmits the license information to be returned, together with the stored history information, to the right management server (see Fig. 2; col. 3, lines 30-31; col. 48, lines 42-43; col. 54, lines 50-53; col. 58, lines 50-53; col./lines 150/43 – 151/36).

26. As per claim 4, 5 and 6, Ginter further discloses wherein

- [claim 4] the second condition is represented by a maximum allowable number of uses of the content which is counted when said content is used after a date when the license information is issued (see Fig. 5B, Budgets 308; col. 55, 19-23; col. 58, lines 63-67; col./line 150/60-151/28);
- [claim 5] the second condition is represented by an expiry date of a validity period of the content which starts on a date when the license information is issued (see col./line 150/60-151/28; Fig. 26; Fig. 26A; Fig. 26B); and
- [claim 6] the second condition is represented by a subset of the first condition, said subset being either a maximum allowable number of uses which is not

Art Unit: 3685

more than a maximum allowable number of uses indicated in the first condition or an expiry date which is earlier than an expiry date indicated in the first condition (see Fig. 5B, Budgets 308; col. 55, 19-23; col. 58, lines 63-67; col./line 150/60-151/28; Fig. 26; Fig. 26A; Fig. 26B).

27. As per claims 7 and 25, Ginter discloses wherein the invalidity judgment unit judges whether the license information is invalid or not based on the updated second condition included in the reissued license information and based on the second condition included in the license information, said condition having been updated by the right management server, said license information having been returned and reissued (see Fig 2 and Fig. 2A; col. 138, lines 14-63).

28. As per claim 8, Ginter discloses wherein the using unit includes a condition updating unit operable to update each of the first condition and the second condition to a new value obtained by subtracting a value of the use right which is consumed under the provision of the use, every time the content is used (see col./lines, 150/60-151/36).

29. As per claims 11 and 19, Ginter discloses wherein the second condition generation unit includes a rule storage unit operable to previously store a rule for generating the second condition, and the second condition generation unit generates the second condition according to the rule stored in the rule storage unit (see Fig. 2, Fig. 2A, Fig 4 and Fig. 5B; col. 54, lines 26-32).

Art Unit: 3685

30. As per claims 12 and 20, Ginter further discloses wherein the rule is defined for each use right of each content, and the second condition generation unit generates the second condition for each license information according to the rule (see Fig. 2, Fig. 2A, Fig 4 and Fig. 5B; col. 54, lines 26-32).

31. As per claims 13 and 21, Ginter further discloses wherein the rule is defined uniformly for any use right, and the second condition generation unit generates the second condition uniformly for any license information according to the rule (see Fig. 2, Fig. 2A, Fig 4 and Fig. 5B; col./line 54/26-55/11).

32. As per claim 10, Ginter discloses wherein the license information includes at least a license information ID for identifying the license information, the first condition, the second condition and a content decryption key for decrypting an encrypted content which is permitted to be used based on the license information (see Fig. 5A; Fig. 5B; Fig. 20; Fig. 26; Fig. 26A; Fig. 26B).

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3685

34. Claims 9, 14-16, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter.

35. As per claims 9 and 24, Ginter discloses wherein the invalidity judgment unit judges whether the license information is invalid or not (see Fig 2 and Fig. 2A; col. 138, lines 14-63; col. 58, lines 64-67; col./line 150/60-151/36) by comparing between a value of the second condition and a value of the item of the usage amount, both of which are included in said license information; and the using unit includes a usage amount calculation unit operable to increment the number of actual uses recorded in the item of the usage amount by an amount of an actual use, every time the content is used (see col./line 150/60-151/26).

36. The Applicant also recites “wherein the license information includes an item of a usage amount into which the number of actual uses of the content is recorded with a default value being 0, when the content is used based on the license information”. However, the recited language is merely description of license which is non-functional descriptive material and do not further limit the claim.

37. As per claims 14 and 26, Ginter disclose all the limitations in claims 1 and 22 as disclosed above. While Ginter discloses a method and system of controlling the methods and events used in metering/budgeting (see Abstract), Ginter does not specifically disclose wherein the invalidity judgment unit judges whether the license information is invalid or not every time power is applied to the user terminal. However,

Art Unit: 3685

the Examiner takes official notice that validating the license every time when a power is applied to a device is old and well known in the art (see cited reference, US Patent No. 6,223,291, col./line 5/62-6/16).

38. It would have been obvious to one of ordinary skill in the art to combine the teachings as both references relates to license. One of the ordinary skill in the art would have been motivated to combine the teachings in order to monitor unauthorized/invalid licensed content on the device.

39. As per claims 15 and 16, the Applicant recites “the invalidity judgment unit judges that the license information is invalid when the maximum allowable number of uses in the second condition is 0 and when a value of an a usage amount included in said license information is not less than a value of the second condition, said usage amount being an item into which the number of actual uses of the content is recorded with a default value being 0 when the content is used based on the license information.” Such claim language, i.e. “when”, is an optional language that does not narrow the claim. See e.g. MPEP §2106 II C. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See: *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int’l Trade Comm’n*, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II. Hence, the prior art reads on the claims.

Conclusion

40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 6,223,291 to Puhl et al.: discloses system and method related to digital certificate and license.
- US Patent No. 5,629,980 to Stefik et al.: disclose system and method of controlling digital usage rights.
- US Patent No. 6,697,948 to Rabin et al.: discloses system and method of controlling/protecting digital rights.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

43. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Art Unit: 3685

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./

Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685